

## **REMARKS**

Claims 1-14 and 18 are pending for examination. The Office has rejected all of the claims under 35 U.S.C. §§ 101 and 103. Reconsideration and allowance of all pending claims is requested.

### **35 U.S.C. § 101 REJECTIONS**

The Patent Office rejected claims 1-14 and 18 as being directed toward non-statutory subject matter. The basis stated for this rejection is that the invention is not within the "technological arts" because no computer or software is recited in the claims. Applicants respectfully traverse this rejection.

On January 11, 2004, Applicants' counsel (the undersigned) and Examiner Robinson Boyce discussed the allowability of the patent application in a telephone conference. Applicants' counsel asked where the two-prong test came from that was recited in the Office Action, and specifically, where the requirement came from that the invention be "within the technological arts". Examiner Robinson Boyce said she would send a citation for that requirement. Applicants' counsel asked whether any procedure that was not computer implemented would ever be patentable. Examiner Robinson Boyce said that no procedure was patentable under the current standards unless it was computer implemented. Applicants' counsel argued that the current claims fall into the safe harbors described in M.P.E.P. § 2106 IV B.2(b)i, including an independent physical act (e.g., providing a result to the financial advisor), manipulation of data representing physical activities (e.g., rating a case and comparing to a predetermined standard) and a limitation to a practical application (e.g., evaluating the performance of a financial advisor). However, Applicants' counsel agreed to review the citation promised by Examiner Robinson Boyce.

Applicants' counsel received an eleven-page fax from Examiner Robinson Boyce on January 12, 2005. This fax included excerpts from the M.P.E.P. starting at 2106 II. Applicants' counsel reviewed the fax and found no requirement that an invention be technological or that a process be computer implemented. In fact, the fax stated that a computer-implemented claim may be statutory "irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth

in the computer program" (fax page 007, lines 5-6; M.P.E.P. 2106 IV B 1(a), page 2100-13, col. 2, lines 5-10)). Applicants' counsel left a voice mail for Examiner Robinson Boyce on January 12, 2005, asking where the material in the fax required that a process be computer implemented, but Applicants' counsel did not receive a return phone call.

As stated in the previous Office Action Reply, the Supreme Court has stated that "anything under the sun that is made by man" is patentable. *Diamond v. Chakrabarty*, 447 U.S. 303, 308-309 (1980). There are three categories of subject matter that are unpatentable: laws of nature, natural phenomena, and abstract ideas. *State Street Bank and Trust Co. v. Signature Financial Group Inc* 149 F.3d 1368, 1373 (Fed. Cir. 1998). The M.P.E.P. states that non-statutory subject matter is limited to these three categories. See page 2100-11. Applicants respectfully submit that the claimed invention does not fall into any of these three categories.

Applicants submit that claims 1-14 and 18 of the present invention qualify as a "process" under 35 U.S.C. § 101. Applicants respectfully submit that although the methods of claims 1-14 can be implemented using a computer or otherwise in certain embodiments, a process does not need to be computer implemented to be statutory. 35 U.S.C. § 101 (processes are patentable, with no distinction as to how implemented).

Applicants further submit that the present invention produces a "useful, concrete and tangible result" related to evaluation of work product. The usefulness of the "numerical values" of original independent claims 1 and 13 would be clear to a person of skill in the relevant art(s). As an example, Applicants submit that the usefulness of the "numerical values" of original claims 1 and 13 would be clear to a person of skill in the technological art of evaluating the performance of financial advisors. However, to expedite prosecution of this case and to further illustrate that claims 1 and 13 cover statutory subject matter, Applicants previously amended these claims to include the steps of compiling the results and providing the results to the financial advisor, which further highlight a concrete and tangible result which a person of ordinary skill in the art would recognize as being useful. For example, as stated in paragraph 0137 of Applicants disclosure, a financial advisor may use this feedback to improve his performance. This is "a useful, concrete and tangible result." As a person of skill in the relevant art(s) would recognize, the numerical value or results of claims 1 and 13 may be used for other purposes, such as removing incompetent financial advisors, allocating

bonuses or raises to the best financial advisors, evaluating the need for additional training or supervision, or evaluating the performance of people who train or supervise financial advisors, and the like. Significantly, the specific analysis and determination of numerical values related to the advice is extremely unique and beneficial in the financial advising industry.

In addition, Applicants submit that the step of "providing said results to the financial advisor" of independent claims 1 and 13 may be an "independent physical act" that puts these claims into a safe harbor for process claims as described in the M.P.E.P. at 2100-15 to -16. Thus, these claims are clearly statutory.

Applicants respectfully submit that the pending claims cover statutory subject matter. Reconsideration of all pending claims is requested.

### **35 U.S.C. § 103 REJECTIONS**

The Patent Office rejected claims 1-14 and 18 as being obvious over US 5,909,669 (Havens) in view of 5,696,907 (Tom). Applicants respectfully traverse this rejection and submit that the references cited do not teach or suggest all of the claim limitations.

During the same phone conference mentioned above, Applicants' counsel argued that the cited references do not teach or suggest "reading a case prepared by a financial advisor" as recited in claim 1. Applicants' counsel argued that Havens teaches evaluating performance by surveying workers, peers, and supervisors, but does not suggest, and teaches away from, reading a case. Applicants' counsel also argued that the credit manager of Tom includes risk assessment and credit analysis for potential customers applying for financial services, in contrast with the present claimed invention, and the credit manager of Tom is not the same as the financial advisor of the present invention. Further, Tom does not teach or suggest "reading a case prepared by a financial advisor" as recited in claim 1. During the phone conference, Examiner Robinson Boyce stated that she was not able to reach a final conclusion on the 103 rejections at that time, but would do so in response to a written request for reconsideration.

As stated in the previous office action reply regarding independent claim 1, Applicants submit that neither reference teaches or suggests the step of "reading a case prepared by the financial advisor, wherein said case provides recommendations", as recited in claim 1. Havens teaches surveying workers, peers, supervisors, etc. (e.g., col. 4, lines 20-41, and col. 11, lines 39-49), but does not teach or suggest reading a particular case prepared by anyone, let alone a financial advisor.

Tom also does not teach or suggest "reading a case prepared by the financial advisor" as recited in claim 1. First, Tom does not teach or suggest "reading a case" prepared by anyone. Second, the "credit manager" of Tom is not the same as the "financial advisor" of the present invention. The "financial advisor" of the present invention is a person who provides financial advice to a client. See, for example, paragraph 0018 of Applicants disclosure. In contrast, the "credit manager" of Tom is a person who receives financial service applications and evaluates information to make decisions regarding business expansion and the like (col. 2, lines 19-24). Thus, Tom does not teach or suggest the financial adviser required in claim 1.

Similarly, independent claim 13 contains the limitation "selecting a case prepared by the financial advisor". Applicants submit that the cited references do not teach or suggest this limitation. In addition, independent claims 1 and 13 may contain other limitations not taught or suggested by the prior art of reference.

Further, applicants submit that the claims that are dependent on claim 1 or on claim 13, either directly or indirectly, are allowable because they are dependent on an allowable base claim. Applicants submit that these dependent claims may contain other elements that further distinguish them from the cited references.

## CONCLUSIONS

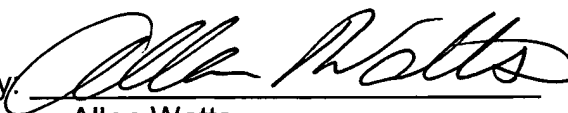
Applicants submit that the pending claims are allowable over the prior art of record. Reconsideration and allowance of all claims is earnestly solicited. As a minimum, if the Office is not able to allow all of the claims at this time, withdrawal of the finality of the Office Action is requested. Further, the Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions or such a conversation may facilitate allowance of the present application or withdrawal of the finality of the office action.

Respectfully submitted,

Date: \_\_\_\_\_

1/20/05

By: \_\_\_\_\_



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